REMARKS

Claims 1, 17 and 33-42 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Fisher et al.* (U.S. Patent 6,247,128) in view of *Lowry* (U.S. Patent 5,946,002) in view of "Dictionary of Computing: Fourth Edition" herein referred to as *Computing* and in further view of *Garcia et al.* (U.S. Patent 5,359,725) and in further view of *Barsness et al.* (U.S. Patent 5,960,206). Claims 1, 17 and 33-42 are also rejected under 35 U.S.C. 103(a) as being unpatentable over *Fisher et al.* in view of *Lowry* in view of "Dictionary of Computing: Fourth Edition" herein referred to as *Computing* and in further view of *Garcia et al.*

Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness.

Claims 1 and 17 include: "parsing the second identifier into a call to a batch file that (i) causes a native-language version of the other software to be installed in the computer system and (ii) calls a translation script which anticipates text files of more than one type; based on the type of file in which the other software is stored, and based on the operating system software, the translation script selecting a translation routine from a set of available translation routines, each set containing a translation routine for each available foreign language under each type of available operating system."

As the PTO recognizes in MPEP §2142:

> ...The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness.....the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made....The Examiner must put aside knowledge of the Applicant's disclosure, refrain from using hindsight, and consider the subject matter claimed 'as a whole.'"

The references fail to teach or suggest the method defined by the claims and described in the description. Specifically, the references do not teach or suggest such method as claimed in amended claims 1 and 17.

Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103 rejection because the cited references fail to teach or even suggest the desirability of the combination. Moreover, the references fail to provide any incentive or motivation supporting the desirability of the combination.

The MPEP §2143.01 provides:

> The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Therefore, the Examiner's combination arises solely from hindsight based on the invention without any showing of suggestion, incentive or motivation in either reference for the combination.

Thus, the Examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met.

The Federal Circuit has, on many occasions, held that there was no basis for combining references to support a 35 U.S.C. §103 rejection. For example, in *In re Geiger*, the court stated in holding that the PTO "failed to establish a *prima facie* case of obviousness":

> Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Monteffore Hospital*, 732 F.2d 15.72, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

The Federal Circuit has also repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings in the prior art. See *e.g., Grain Processing Corp. v. American Maize-Products*, 840 F.2d 902, 907, 5 USPQ2d 1798, 1792 (Fed. Cir. 1989).

More recently, the Federal Circuit found motivation absent in *In re Rouffet* , 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998). In this case, the court concluded that the board had "reversibly erred in determining that one of [ordinary] skill in the art would have been motivated to combine these references in a manner that rendered the claimed invention [to have been] obvious." The court noted that to "prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the Examiner to show a motivation to combine the references that create the case of obviousness." The court further noted that there were three possible sources for such motivation, namely "(1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art." Here, according to the court, the board had relied simply upon "the high level of skill in the art to provide the necessary motivation," without explaining what specific understanding or technological principle within the knowledge of one of ordinary skill in the art would have suggested the combination. Notably, the court wrote: "If such a rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance."

Therefore, independent claims 1 and 17, and the claims dependent therefrom are submitted to be allowable.

In view of the above, it is respectfully submitted that claims 1, 17 and 33-42 are in condition for allowance. Accordingly, an early Notice of Allowance is courteously solicited.

Respectfully submitted,

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